

## REMARKS

By this amendment, claims 1, 4-11 and 13-22 have been amended. A number of the claims were edited to place the same in better form. Claims 1-11 and 13-22 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

### Rejection under 35 U.S.C. §103

Claim 1 recites a consumer electronic device configured for making its content available comprising:

an output means configured to generate a human perceptual signal of content, wherein the content is to be made available to share with a further electronic device in a vicinity of the consumer electronic device;

a transmitter configured to transmit a human non-perceptual signal; and

a control unit configured (i) to control the output means, (ii) to create a representation of the human perceptual signal of the content being generated by the output means, and (iii) to instruct the transmitter to broadcast a human non-perceptual signal comprising the representation;

wherein the control unit is further configured to instruct the output means to make a received human perceptual signal, generated from a further human non-perceptual signal that is received from a further electronic device for accessing new content, more noticeable in response to being received from a nearby further electronic device and less noticeable in response to being received from a remote further electronic device.

Support for the amendments to claim 1 (as well as for claims 9 and 18-22) can be found in the specification at least on page 1, lines 26-28; page 2, lines 1-2; page 6, lines 14-15; and Figures 3 and 4.

Claims 1-7, 9-11, 13-16 and 18-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ma et al. (U.S. PAT. 6,819,924, hereinafter “**Ma**”) in view of Renney (U.S. PAT. 5,939,981, hereinafter “**Renney**”).

With respect to claim 1, as amended herein, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

## **1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Ma** and **Renney** references cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Ma** nor **Renney** teaches a consumer electronic device “... for making its content available ... to share with a further electronic device in a *vicinity* of the consumer electronic device ... and a *control unit* configured **(i)** to *control* ... output means, **(ii)** to *create* a representation of the human perceptual signal of *the content* being generated by the output means, and **(iii)** to *instruct* the transmitter to broadcast a *human non-perceptual signal* comprising the representation

... the *control unit* ... *further configured to instruct* the output means to make a received human perceptual signal, generated from a further human non-perceptual signal that is received from a further electronic device for accessing new content, more noticeable in response to being received from a nearby further electronic device and less noticeable in response to being received from a remote further electronic device" [emphasis added] as is now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, while **Ma** teaches "a method for measuring perceptual quality of voice signals, audio signals, audio-video signals, and multimedia signals in communication equipment" (See Ma Abstract) with the use of a test signal via a network and a pre-stored representation of a reference signal on a local quality measurement unit (See Ma column 4, lines 15-32), **Ma** does not teach or suggest a consumer electronic device "... for *making its content available* ... to *share* with a further electronic device in a *vicinity* of the consumer electronic device ... and a *control unit* configured (*i*) to *control* ... output means, (*ii*) to *create* a representation of the human perceptual signal of *the content* being *generated by* the output means, and (*iii*) to *instruct* the transmitter to broadcast a *human non-perceptual signal* comprising the representation ... the *control unit* ... *further configured to instruct* the output means to make a received human perceptual signal, generated from a further human non-perceptual signal that is received from a further electronic device for accessing new content, more noticeable in response to being received from a nearby further electronic device and less noticeable in response to being received from a remote further electronic device" as is specifically recited in claim 1 of the present application.

In further contrast, **Renney** teaches an item locator with attachable receiver/transmitter in which "a handheld device" with a control panel having *selector buttons* for each of "multiple sensors/chips" ... that ... "are applied to objects the user desires to locate." In response to a user depression of a preselected button, the "transmitter sends a signal containing preselected code." ... "The receiver in each

multiple sensors/chip reads the code and if a match is obtained the receiver enables an audio generator ... to send a tone through an audio speaker.” In the handheld device, a second receiver ... matches the code ... “and enables a second audio tone generator to send a second tone through a second speaker. Both tones are controlled to become louder the closer the hand held devices is to the desired multiple sensors/chip.” [emphasis added] (see Renney Abstract, and at column 6, lines 11-33), **Renney** does not teach or suggest a consumer electronic device “... for *making its content available* ... to *share* with a further electronic device in a *vicinity* of the consumer electronic device ... and a *control unit* configured (*i*) to *control* ... output means, (*ii*) to *create* a representation of the human perceptual signal of *the content* being *generated by* the output means, *and* (*iii*) to *instruct* the transmitter to broadcast a *human non-perceptual signal* comprising the representation ... the *control unit* ... *further configured to instruct* the output means to make a received human perceptual signal, generated from a further human non-perceptual signal that is received from a further electronic device for accessing new content, more noticeable in response to being received from a nearby further electronic device and less noticeable in response to being received from a remote further electronic device” as is specifically recited in claim 1 of the present application.

Thus, for this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## 2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Ma** and **Renney** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Ma** nor **Renney** teaches, or even suggests, the desirability of the combination since neither teaches the specific consumer electronic device “*... for making its content available ... to share with a further electronic device in a vicinity of the consumer electronic device ... and a control unit configured (i) to control ... output means, (ii) to create a representation of the human perceptual signal of the content being generated by the output means, and (iii) to instruct the transmitter to broadcast a human non-perceptual signal comprising the representation ... the control unit ... further configured to instruct the output means to make a received human perceptual signal, generated from a further human non-perceptual signal that is received from a further electronic device for accessing new content*, more noticeable in response to being received from a nearby further electronic device and less noticeable in response to being received from a remote further electronic device” as specified above and as claimed in claim 1.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the combination as suggested by the office action arises

solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 2-7 depend from and further limit independent claim 1 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claim 9 has been amended in a manner similar to the amendments to claim 1. Accordingly, for similar reasons as stated with respect to overcoming the rejection of claim 1, claim 9 is believed allowable and an early formal notice thereof is requested. Claims 10-11, 13-16, 18 depend from and further limit independent claim 9 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Claims 19, 20, 21 and 22 have been amended in a manner similar to the amendments to claim 1. Accordingly, for similar reasons as stated with respect to overcoming the rejection of claim 1, claims 19, 20, 21, and 22 are believed allowable and an early formal notice thereof is requested. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is respectfully requested.

Claims 8 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Ma** in view of **Renney** and further in view of **Foschini et al.** (U.S. PUB. 2003/0104808, hereinafter "**Foschini**"). (It is noted that the office action mailed 11/24/2008, page 12, line 6, identifies Foschini as U.S. PUB. 2002/0136231, which is to Leatherbury et al. However, in PTO-892 accompanying the Office Action of July 9, 2007 correctly identifies Foschini et al. as U.S. PUB. 2003/0104808.) Applicant respectfully traverses this rejection for at least the following reasons. Claim 8 depends from and

further limits allowable independent claim 1 and therefore is allowable as well. Claim 17 depends from and further limits allowable independent claim 9 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 9, 19, 20, 21, and 22 are in condition for allowance. Claims 2-8 depend from and further limit independent claim 1 and therefore are allowable as well. Claims 10-11 and 13-18 depend from and further limit independent claim 9 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-11 and 13-22 is requested.

Respectfully submitted,

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